

particulate as fillers. However, Butler fails to teach that the LAB coated film surface is visually uniform. The Examiner further states that Zhu discloses a coating composition of LAB comprising colloidal silica dispersion wherein the particle size can be larger and will not diminish LAB properties but change the visual properties. Therefore, the Examiner feels it would have been obvious to one having ordinary skill in the art to utilize Zhu's teaching of using large size silica particles in LAB in the invention of Butler to obtain visual uniformity of the film surface.

Response:

The Examiner has stated that the Applicants' arguments filed September 10, 2001 (paper no. 16) were fully considered, but were not found to be persuasive. The Examiner further states that the argument "is not deemed to be convincing because 'how to coat a film' is directed to a process condition which is not germane to the issue of patentability of the product itself."

Applicants respectfully disagree. Applicants do not propose that the article of the present invention can only be made using a particular process. However, the teaching in the art with respect to how an article is made is indeed germane to the patentability of an article. If the references cited by the Examiner fail to specifically teach the article of the present invention, it is appropriate to look at the process to determine if the process taught in the reference could make the article of the present invention. Applicants believe this would require an "obvious to try" standard, a standard that is insufficient to find obviousness. The mere need for experimentation to determine parameters needed to make an article is an example of the often rejected obvious-to-try standard and falls short of the statutory obviousness of 35 U.S.C. § 103. (*Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). Lacking any teaching in Butler or Zhu as to how to accomplish the article of the present invention, one skilled in the art would be left to experiment until such results were obtained. That is, one skilled in the art would require undue experimentation in this "obvious to try" circumstance.

As stated in paper no. 16, Applicants understand Butler as teaching a process for a coating that is a non-reproducible random coating, much like an orange peel effect. Butler obtains splotchy patterned coatings. The "pattern" is unpredictable and non-reproducible, although the coating conditions may be reproduced. Furthermore,

what Butler is creating is a microscopic pattern, which is difficult to see (note that the images are SEMS at 50X magnification).

Applicants understand Zhu as teaching the use of colloidal silica in the range of 1 nanometer to 1 micrometer, with a preferred range of 7 to 75 nanometers. Furthermore, Zhu uses silica to improve the abrasion resistance of his coatings (1-12, 2-15, 5-5, etc.).

It appears that Zhu does not measure the optical properties of his coatings, although they are described as "transparent, translucent, or opaque" (Col. 5, Ln 29). Zhu is particularly concerned with the transmissive properties (i.e., degree of transparency) of the cured coatings. This is in contrast to the reflective properties of the present invention, wherein the visual appearance of the film (reflective properties) is what is being claimed, and not whether or not one can view through the film (transmissive properties).

See the enclosed Declaration of Mark E. Fagan, regarding the sizes of the particles described in Butler and Zhu.

Neither Butler nor Zhu describe how to coat a film with an LAB, such that the film has the appearance of a uniform film; that is, the viewer is unable to distinguish between the coated and uncoated macroscopic portions of the film. Uniformity of microscopic portions of the films is not what is being claimed. Butler does not make the present invention obvious and the combination with Zhu, contrary to the Examiner's position, does not cure the shortcomings of Butler.

Applicants respectfully suggest that the rejections based on Butler in view of Zhu are improper and all such rejections should be withdrawn.

Paragraph 4 of the Office Action rejects claims 5-6, 9, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Butler in view of Zhu and Blackwell (5,401,547).

Response:

Applicants' arguments set forth in paper no. 16 stated that the Butler – Zhu combination fails. The addition of Blackwell still does not cure this failure. Merely using two different LABs, as in Blackwell, does not make the use of two different LABs in the present invention obvious. Blackwell describes a fully coated film using

two different LABs (for different adhesion levels). However, Blackwell (as well as Butler and Zhu) does not describe or even suggest how to deal with the LAB coated portion of a film and an uncoated portion of the film. Since Blackwell never deals with this issue, there is no suggestion of a modification of the coatings to solve the problem of this interface. Therefore, there is no expectation of success and this combination of references also fails.

Applicants respectfully suggest this paper is fully responsive to the Office Action and the remarks and amendments have resolved the Examiner's outstanding objections and rejections. However, if after fully considering Applicants' response, there are issues remaining, Applicants request the Examiner telephone the undersigned to timely resolve any remaining issues. Applicants wish to present a clear record to the Board of Appeals, should any remaining issues remain unresolved.

Please charge any fees that may be associated with this paper to Deposit Account No. 13-3723.

Respectfully Submitted,

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